IN THE HIGH COURT OF JUDICATURE AT BOMBAY
ORDINARY ORIGINAL CIVIL JURISDICTION

NOTICE OF MOTION NO.3529 OF 2003
IN
SUIT NO.3726 OF 2003

Manak Chand Jain & Anr. ..Plaintiffs.

Vs.

Cello Plstic Products ..Defendants.

Mr.Shekhar Shetye i/b.M/s.Gajaria & Co. for the Plaintiffs.

Mr.Virag Tulzapurkar, Senior Counsel with Mr.Salil Shah, Mr.H.J.Engineer & Ms.Rupal Narielwala i/b.M/s.Gordhandas & Fozdar for the Defendants.

CORAM : S.J. VAZIFDAR, J.
DATED : 18TH SEPTEMBER, 2006

P.C. :

The suit is filed to restrain the Defendants from selling or offering for sale any writing instruments as shown in Exhibit "D" and/or applying the Plaintiff’s registered designs described in Exhibits "B-1" and "B-2" to the plaint or any other identical or deceptively similar design/designs to writing instruments, writing instrument refill holders, pens or other goods falling in Class 16-09 of the Designs Act, 2000 and Designs Rules, 2001 so as to infringe the Plaintiff’s said registered designs.

2. The Plaintiffs have also sought an injunction restraining the Defendants from in any manner manufacturing, packing, using, selling or offering for sale fountain pens, ball pens, roller pens, pens, ink pens, writing instruments, refill holders or any other goods bearing the design, colour scheme, layout, getup or trade dress described in Exhibit "D" to the plaint or any other design, colour scheme, layout, getup or trade dress identical to or deceptively similar to that of the Plaintiff's products described in Exhibit "C" to the plaint so as to pass off their goods as and for the goods of the Plaintiffs. The Plaintiffs have also sought damages.

3. Plaintiff No.2 was incorporated in 1990 and claims to be a pioneer of gel ink pens. Plaintiff No.1 is the Managing Director of Plaintiff No.2. Plaintiff No.2 claims to be the largest producer of plastic ball pens in India.

4. The Plaintiffs' case is that in or around March, 2002, Plaintiff No.1 conceived a new and original design/ornamentation and pattern in respect of "writing instrument refill holders". On 4.4.2002 Plaintiff No.1 applied for and obtained registration

of the said design in respect of "Writing Instrument Refill Holder" in Class 19-06 of Schedule III of the said rules. The registration is valid and subsisting.

The Plaintiffs also claim that in or around March, 2002, Plaintiff No.1, as a Managing Director of Plaintiff No.2, conceived of another new and unique original design/ornamentation and pattern in respect of "Writing Instruments" in respect whereof, the Plaintiffs have applied for and obtained registration on 28th August, 2002 under Class 19-06. The registration certificates state that the novelty resides in the shape and configuration of the WRITING INSTRUMENT as illustrated and that no claim is made by virtue of the registration in respect of the use of words, letters, numbers of trade marks endorsed on this representation sheet. It further states that no claim is made by virtue of this registration in respect of any mechanical or other action of the mechanism whatever or in respect of any mode or principle of construction of the article.

Lastly, the certificate states that no claim is made by virtue of this registration for extraneous

matter which does not form an integral part of the design.

5. It may be noted that the refill which was registered as stated earlier, also formed a part of this registration.

6. According to the Plaintiffs, Plaintiff No.2 has applied the said designs to its products and has been selling the same since about 28th November, 2002 on an extensive scale all over the country. The Plaintiffs' various products are advertised in different media. The Plaintiffs have bifurcated the sales figure in respect of the products generally and in respect of the products bearing the said design. The sales turnover runs into crores of rupees. The Defendants however have denied the same in paragraph 14 of their affidavit in reply. In the rejoinder, the Plaintiffs have craved leave to rely upon the documents in respect of their averments regarding the turnover.

7. In the connected matter viz. Notice of Motion No.3528 of 2003 in Suit No.3725 of 2003 between the same parties, I have already set out the provisions of sections 4, 19 and 22 of the Act. It is not

necessary therefore to reproduce them in this order. The provisions were relied upon by Mr.Tulzapurkar, the learned Senior counsel appearing on behalf of the Defendants in support of his contention that the Plaintiffs were not entitled to an injunction on the ground of infringement of designs. This contention was based on the fact of prior publication of the said design.

8. In the affidavit in reply, the Defendants have stated that they are the leading manufacturers, dealers and sellers of pens and other stationery products and, as such, adopt various new designs of pens from time to time and market the same under various names such as ALPHA GEL, GRIPPER, POINTEC and CLEAR. The Defendants have further stated that the normal trend of the pen industry in India is to visit word exhibitions on pens around the world and to procure samples. The ideas obtained from the samples are then converted into new designs according to the requirements of the domestic market and then launched. The Defendants also call for pamphlets and catalogues from the foreign manufacturers of pens and stationery articles and from that select the design of pens for the purpose of manufacturing and selling the same in the Indian

market. The Defendants also get their moulds of pens manufactured from the foreign manufacturers whose designs the Defendants adopt. As in the other matter though copying is not the word used in the affidavit, that is in substance the purport of the pleading. The Defendants have further stated that their partners also visit foreign countries regularly and from there bring samples of pens manufactured by foreign manufacturers for the purpose of manufacturing pens of such new designs in India.

9. In the present case, the Defendants case further is that one of their partners visited Korea in February, 2001 and had visited various manufacturers of pens in Korea and brought some pens including the pen bearing the name "JOY" manufactured by a company known as SIS i.e. Kims Enterprise Company Ltd. (KECL), Seoul, Korea, for the purpose of manufacturing a new type of pen in India.

10. Photostat copies of the pens are annexed to the affidavit in reply. From the various models, the Defendants selected the model bearing the name "JOY" and negotiated with KECL for permission to adopt the same design. The Defendant’s case is that KECL

permitted them to manufacture the same with the similar model and getup. Thereupon, in or around April, 2001 the Defendants adopted the design of the pen and started selling the same in the open market under the name "Cello Gel Friendship". The Defendants also got the mould prepared from the manufacturer of the pen. The Defendants accordingly contend that the Plaintiff’s designs are not new and original as the same were already published in Korea, Japan and other countries prior to the date of application for registration.

11. In the affidavit in rejoinder, the Plaintiffs denied inter-alia the aforesaid contentions. The Plaintiffs denied that the Defendant’s partner visited Korea in February, 2001 and brought the said pens manufactured by the Korean Company.

12. In the affidavit in sur-rejoinder, the Defendants stated that their partner Pankaj G. Rathod had visited Korea in February, 2001 and brought the said pens with him. The Defendants have specifically stated that the said Rathod left for Korea on 23.2.2001 and returned on 26.2.2001. The fact of this visit stands established from the passport of the said Rathod.

13. Faced with this, Mr.Shetye contended that Rathod's passport indicates that he was a frequent traveller abroad and that it was therefore obvious that he was travelling abroad for other purposes and not merely for the purpose of collecting the designs of pens from other manufacturers.

14. I have dealt with and rejected a similar argument in my order in Notice of Motion No.3528 of 2003. For the same reason, the submission is rejected in this Notice of Motion as well. The other contentions which were raised in Notice of Motion No.3528 of 2003 are also raised in the present case. For the reasons mentioned in my order in that Notice of Motion, the same are rejected.

15. In the totality of circumstances, prima-facie, it does appear that the Defendants have established their case. I have so held also in Notice of Motion No.3528 of 2003. Although the two matters are different, this aspect is common to both the matters. If I am correct in what I have held in Notice of Motion No.3528 of 2003, the finding is of added value in the present matter in deciding the Defendant's case in this matter on this issue.

16. In view of the above finding, I will ignore the Defendants' reliance upon the certificate issued by M/s.Kims Enterprises Co. Ltd. (Exhibit 2 to the affidavit in sur-rejoinder).

17. As pointed out by Mr.Tulzapurkar, it is important to note that the sample of the pen manufactured by KECL (Exhibit 1 to the affidavit in reply) indicates that the same is not only similar but almost identical even in small respects to the Defendants' products. There is no dispute and, indeed, there cannot be any dispute that the Defendants pens are similar in design to the Plaintiffs' products. However, the similarity between the Plaintiffs' products and the Defendants' products manufactured by KECL are closer. Prima-facie, therefore, it appears that the Defendants have copied the products manufactured by KECL.

18. For the reasons mentioned in my order dated 18.9.2006 in Notice of Motion No.3528 of 2003, it must be held that the Plaintiffs' design is not new or original as the same had already been published in Korea prior to the date of application for

registration by the Plaintiffs. Further, it must also be held that the Defendants had copied the same.

19. The Plaintiffs are not therefore entitled for any relief based on their registered designs.

20. For the reasons mentioned in my order in Notice of Motion No.3528 of 2003, it is not necessary for me to consider Mr.Tulzapurkar's other submissions regarding the Plaintiffs' case of infringement of design. Nor is it necessary to deal with Mr.Tulzapurkaer's other contentions which were also raised in Notice of Motion No.3528 of 2003.

21. I have found, prima-facie atleast, the trade practice alleged by the Defendant to be well founded. Added to this, is the fact that the Plaintiff has not given any details of how the design, colour scheme, layout, get-up and trade dress of their products were conceived/developed. Further, the colour scheme, trade dress etc. of the Plaintiff's products is indeed very similar to the Defendants products and, accordingly, to the products manufactured by KECL. On a consideration of all the facts and circumstances of the case,

prima-facie atleast, the Defendants have established that the Plaintiffs have themselves copied the same from another party viz. KECL. In the circumstances, the Plaintiff is not entitled to any reliefs on the basis of passing of. (See *Abdul versus Mahomedaly, 3 BLR, 220*)

22. The Notice of Motion is therefore dismissed.